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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/599,371 06/22/00 NELSON

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027267 HM12/0906  
WIGGIN & DANA LLP  
ATTENTION: PATENT DOCKETING  
ONE CENTURY TOWER, P.O. BOX 1832  
NEW HAVEN CT 06508-1832

EXAMINER

LEVY, N

ART UNIT	PAPER NUMBER
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1616

DATE MAILED:

09/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09 599371

Applicant(s)

Nelson et al

Examiner

NBL Guy

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on 8/31/01
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1 - 42 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 1 - 42 are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

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Receipt is acknowledged of Declaration, address change, IDS, and IDS (8/3/01).

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 33, 34, drawn to positions, classified in class 514, subclass 345.
- II. Claims 12-23, drawn to methods, classified in class 424, subclass 405.
- III. Claims 24-26, drawn to fuel, classified in class 44, subclass 329.
- IV. Claims 27-29, drawn to coated substrates, classified in class 428, subclass 40.1.
- V. Claims 30, 31, drawn to coatings, classified in class 427, subclass 154.
- VI. Claims 32, drawn to fibers, classified in class 252, subclass 8.84.
- VII. Claim 35, drawn to adhesives, classified in class 523, subclass 111.
- VIII. Claim 36, drawn to elastomers, classified in class 523, subclass 122.
- IX. Claim 37, drawn to sealants, classified in class 106, subclass 15.05.
- X. Claim 38, drawn to cosmetic, classified in class 424, subclass 401.
- XI. Claims 39, 40, drawn to cellulose preservation, classified in class 504, subclass 114.
- XII. Claim 41, drawn to detergent preservation, classified in class 510, subclass 103.
- XIII. Claim 42, drawn to drugs, classified in class 424, subclass 49.

The inventions are distinct, each from the other because:

Inventions I and III-XIII and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the

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product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the methods of Group II are independent and patentably distinct from the various compositions as alternative compositions limonene for example, could be used in the methods, and the compositions could be used for other purposes.

The various compositions are independent and patentably distinct each from the other, as they can be used for alternative purposes, such as perfumes, pesticides, fertilizers.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Groups of any type is not required for Groups of any other type , restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of metal source: zinc, copper or silver.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 8-15, 19-23 are generic.

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This application contains claims directed to the following patentably distinct species of the claimed invention: species of pyrithione adduct: alkali/metal, metal ethanolamine, chitosan, disulfide.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 8-13, 16-23 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of Adduct or salt.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 8-13, 16-23 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

A telephone call was made to Attorney Todd Garabedian on 8/13/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday to Friday from 7 am to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy:mv

August 20, 2001



NEIL S. LEVY  
PRIMARY EXAMINER